

Remarks/Arguments

Claims 2-7 and 9-17 are pending in the application. Claims 2-7 and 9-17 are rejected. The Examiner states that the following combinations would be allowable: 11, 12, 13, and 15 or 17, 10, 12 or 13, and 15. New claims 18-20 have been added to reflect these combinations.

The reference to claim 11 in new claims 19 and 20 has been omitted since claim 11 is a method claim, and new claims 19 and 20 have been written as system claims. Applicant respectfully submits that new claims 18-20 are in condition for allowance, and favorable action is requested.

Claim Rejections Under 35 USC § 103

Claims 2-7 and 9-17 are rejected under 35 USC 103(a) as being unpatentable over Mendez et al (US 6,203,708) and further in view of Segur (US 6,212,550).

Applicant respectfully traverses the rejections of all claims. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, and the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Office Action does not identify any suggestion or motivation for the cited combination. The combination therefore does not amount to more than impermissible hindsight

reconstruction of the claimed invention, and therefore a prima facie case of obviousness has not been established.

Further, Segur teaches that user's manually select messages for download. This goes against the teaching in Mendez for automatic synchronization. Therefore, persons skilled in the art would not be motivated to combine Segur with Mendez. (Segur, col. 2, lines 10-25 and col. 3, lines 50-55.) As the rejection is based on alleged common knowledge in the art or official notice, Applicant respectfully requests the Examiner to provide supporting evidence if the obviousness rejection is not to be withdrawn, pursuant to MPEP §2144.03.

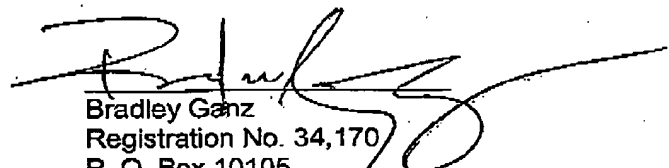
In view of the foregoing reasons for distinguishing over the cited references, Applicant has not raised other possible grounds for traversing the rejections, and therefore nothing herein should be deemed as acquiescence in any rejection or waiver of arguments not expressed herein.

CONCLUSION

Applicant submits that in view of the foregoing remarks, the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees, including extension fees, which may be required, or credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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